

REMARKS

Favorable reconsideration of this application, in light of the preceding amendments and following remarks, is respectfully requested.

Claims 1-8 and 10-16 are pending in this application. Claims 1, 10, 13, and 16 are amended. Claims 1, 7, 11, 13 and 16 are the independent claims.

Rejections under 35 U.S.C. § 103

Claims 1-3 and 5-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2002/0001274 to Nakajima et al. ("Nakajima"). Applicant respectfully traverses this rejection for the reasons detailed below.

According to the new Examination Guidelines for Determining Obviousness under 35 U.S.C. § 103 in view of the Supreme Court decision of *KSR International, Co. v. Teleflex, Inc.* it is stated that the proper analysis for a determination of obviousness is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. The key to supporting to any rejection under 35 U.S.C. § 103 is the clear articulation of the reasons why the claimed invention would have been obvious. An Office Action must explain why the differences between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. See 72 Fed. Reg. 57526, 57528-529 (Oct. 10, 2007).

With respect to claim 1, Applicant initially notes that the Office Action on pages 2 and 3 state that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide either one of the mark of [sic] the space with a minimum pit length at least as small as 2T, since it has been held that discovering an optimum value of a result effective variable (Specifically, the value of "n" in pit lengths disclosed as nT) involves only routine skill in the art."

Applicant respectfully disagrees with this assertion. As an initial matter, the MPEP states in section 2144.05 that “A particular parameter must first be recognized as a result effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation.” In the Office Action no such analysis making the determination that the minimum pit length is a result effective variable has been made. Rather, the Office Action merely makes a conclusionary statement that the variable is a result effective variable that involves only routine skill in the art. Obviousness rejections cannot be sustained by mere conclusory statements (See *Id.* at 57529). Applicant respectfully asserts that this is not a clear articulation of why the claimed combination would have been obvious. Further, the range claimed has not been shown to be found in the prior art. Therefore, Applicant respectfully asserts that the optical disc recited in claim 1 has not been shown to be rendered obvious to one of ordinary skill in the art as required by the amended guidelines and therefore an obviousness rejection is not proper.

Applicant further respectfully notes that similar language is found for all the independent claims, claims 1, 7, 11, 13 and 16, and therefore, Applicant respectfully asserts that a proper case of obviousness has not been set forth for independent claims 1, 7, 11, 13, and 16. Therefore, Applicant respectfully requests that the rejections of the pending claims under 35 U.S.C. § 103(a) as being obvious as set forth in the Office Action mailed August 9, 2007 be removed.

Notwithstanding the deficiencies of the prior art as rendering the pending claims obvious for the reasons set forth above, Applicant further asserts that the pending claims are not obvious for additional reasons as set forth below. For example, claim 1 recites a high-density read-only optical disc including, among other things, “the Lead-In area including a specific area having a straight pit-shaped line created by repeated marks and spaces such that the same tracking servo operation can be successively performed over the whole data area of the disc.”

Applicant respectfully asserts that the Nakajima reference does not teach or suggest all the claim limitations as recited in claim 1 and particularly the limitations quoted above. Further, no clear articulation as to why one skilled in the art would find the claimed invention obviousness in view of Nakajima has been set forth.

A review of the Nakajima reference yields that the Nakajima does not at all refer to using the same tracking servo operation over the whole data area of the disc. Rather, the Nakajima reference is silent with respect to servo operations. Because the Nakajima reference does not refer to servo operations and no clear articulation of why the claimed combination would have been obvious has been made to bridge the gap of insufficiency found in the Nakajima reference. For at least this reason, Applicant respectfully requests that the rejection of claim 1 and its dependent claims 2-6 as being unpatentable over the Nakajima reference be removed.

Claims 4, 7-8, and 10-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakajima and in view of Applicants Admitted Prior Art (AAPA). Applicant respectfully traverses this rejection for the reasons detailed below.

Applicant respectfully asserts that claim 4 is allowable at least by reason of its dependency. Claim 7 recites similar language to that recited above with respect to claim 1. However, claim 7 has been rejected as being unpatentable over the Nakajima reference in view of the allegedly Applicants Admitted Prior Art. It has been stated above with respect to claim 1 why the Nakajima reference is deficient in showing that claim 1 is obvious. Applicant respectfully asserts that claim 7 contains similar language to that discussed above with respect to claim 1 and therefore the Nakajima reference is also insufficient with respect to claim 7.

The allegedly Admitted Prior Art does not cure the insufficiencies of the Nakajima reference. For example, the allegedly Admitted Prior Art states in paragraph [0015] (of the published application) "Therefore, different tracking servo operations, i.e., a push/pull tracking

servo operation and a DPD tracking servo operation, must be performed on a single BD-ROM loaded in the optical disc apparatus, such that a complicated algorithm is needed to control a plurality of tracking servos and large-sized optical disc apparatus as also needed.” Therefore, not only does the allegedly Applicant Admitted Prior Art not bridge the gap of the insufficiencies of the Nakajima reference, rather it recites that BD-ROMs require a plurality of servo operations for the same disc, and therefore, teaches away from the method recited in claim 7. Of course, teaching away from claim language is well-known to be indicative that an invention is not obvious in view of the cited references. See, for example, MPEP 2145.

In view of the arguments set forth above, Applicant respectfully requests that independent claim 7 and its dependent claim 10 have the rejections under 35 U.S.C. § 103(a) over Nakajima in view of the allegedly Applicant Admitted Prior Art be removed.

Applicant respectfully asserts that the independent claims 11, 13 and 16 along with their dependent claims also include language similar to that recited above with respect to claims 1 and/or 7, and are therefore not obvious over the cited references at least for the reasons set forth with respect to claims 1 and/or 7.

CONCLUSION

In view of the above remarks and amendments, the Applicant respectfully submits that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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By


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